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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No : 10/645,574
Applicant : McNulty
Filed : August 22, 2003
Title : Head Cover Trimming System

TC/A.U. : 3724
Examiner : C. Blake

Docket No. : MCN003
Customer No.: 27137

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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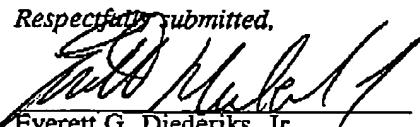
Sir:

The below identified communication(s) or document(s) is(are) submitted in the above application or proceeding:

Petition To Commissioner Issue Fee Transmittal
 Information Disclosure Statement Check in the Amount of \$
with ___ ref. Assignment
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Respectfully submitted,


Everett G. Diederiks, Jr.
Attorney for Applicant
Registration Number: 33,323

Date May 23, 2005

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PETITION TO COMMISIONER PURSUANT TO 37 C.F.R. § 1.144

Sir:

The above-identified application was filed with 21 claims, of which 1-19 are product claims and claims 20 and 21 are method claims. The application was specifically drafted with subcombination claims 2-13 being directed to a cutting head system, subcombination claims 14-19 being directed to a head cap, and independent claim 1 constituting a combination claim including all the particulars of the independent subcombination claims 2 and 14.

In an Office Action dated December 29, 2004, the Examiner set forth a four-way restriction in the application. More specifically, the Examiner held that distinct inventions are covered by combination claim 1, subcombination claims 2-13,

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Petition on Restriction

subcombination claims 14-19, and method claims 20 and 21 respectively. Therefore, the Examiner considers that four separate inventions have been set forth for this individual inventor which require four separate applications. The restriction was traversed with respect to claims 1-19 in a response filed on January 25, 2005 and simply requested reconsideration of the product/method claim restriction.

In a first Office Action on the merits in this case, the Examiner continued to maintain her position with respect to the restriction of both the subcombination claims 2-13 and 14-19 and combination claim 1. The Examiner made the restriction requirement final in this Office Action. The Applicant respectfully submits that the Examiner's position regarding the restriction of the combination and sub-combination claims is improper. More specifically, given that claim 1 links the sub-combination claims 2-13 and 14-19, the restriction requirement maintained by the Examiner is improper. In particular, it is respectfully submitted that neither claim set 2-13 nor claim set 14-19 can be properly restricted from combination claim 1. In making the restriction requirement, the Examiner correctly identifies M.P.E.P. § 806.0(c). This section clearly specifies that supporting a requirement for restriction under combination/sub-combination requires two-way distinctiveness. That is, the inventions can be shown to be distinct only if: a) the combination as claimed does not require the particulars of the sub-combination; and b) the sub-combination can be shown to have utility either by itself or in other and different relations. The M.P.E.P. clearly states that, when these factors are not shown, the inventions are not distinct, such that a restriction is not proper.

In the present case, the Applicant would admit that the sub-combination claims can have separate utility. However, combination claim 1 requires all the particulars of each sub-combination claims 2-13 and 14-19 such that claim 1 cannot properly be restricted from either of these claim sets. Specifically, combination claim 1 contains word-for-word, each of the limitations of claims 2 and 14.

In attempting to restrict these claim sets, the Examiner relies upon Example 3 provided in M.P.E.P. § 806.05(c). However, Example 3 is not relevant in this situation.

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Example 3 concerns when multiple combination claims are presented such that some combination claims recite specific features of the sub-combination but other combination claims give evidence that the sub-combination is not essential to the combination. In the present case, there is only a single combination claim.

It is also interesting to note that the restriction requirement presented between the combination and sub-combination claims was not made utilizing the form paragraph for combination/sub-combination restrictions. This form paragraph specifically recites the criteria for distinctiveness and, as set forth above, specifically requires the combination as claimed to not require the particulars of the sub-combination as claimed. To this end, the Examiner has not shown the two-way distinctiveness required. In view of the above, it is respectfully submitted that the Office Action does not set forth a proper restriction between claim 1 and claims 2-13 or claims 14-19. Instead, it is submitted that these restrictions have been improperly made such that withdrawal of these separate groupings of claims 1, 2-13 and 14-19 is respectfully requested.

Respectfully submitted,



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Date: May 23, 2005
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